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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,093	02/02/2004	Philip J. Simpson	029011/0308042	2037

27498 7590 10/29/2009
PILLSBURY WINTHROP SHAW PITTMAN LLP
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EXAMINER

ANDERSON, GREGORY A

ART UNIT	PAPER NUMBER
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3773

NOTIFICATION DATE	DELIVERY MODE
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10/29/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket_ip@pillsburylaw.com

Office Action Summary

Application No.

10/771,093

Applicant(s)

SIMPSON ET AL.

Examiner

GREGORY ANDERSON

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,5,7-9,11,14-25 and 27-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,8,11,15-25 and 27-29 is/are rejected.
- 7) ☒ Claim(s) 4,7,9,14,30 and 31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 13 August 2009 has been entered.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 5, 8, 11, 15-25 and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lambert et al. 3,605,837 in view of Miller et al. 3,797,343.

Lambert et al. discloses a system comprising: a bearing block 202, a first cutting element 14, the first cutting element being an eccentric disc (Fig. 2) rotatably connected to the bearing block by an axle 26, wherein the first cutting element is configured to rotate eccentrically, and a drive mechanism (Fig. 1) operatively connected to the first cutting element for providing torque about the axle of the first cutting element. Lambert et al. further discloses the first cutting element being adapted for cutting tissue or man-made materials (Col. 3 ll. 36-41). Lambert further discloses the drive mechanism

including a bevel gear 62 assembly, a crank 222 assembly, pinion assembly (Col. 7 ll. 15-21), and a pulley assembly 72. Lambert et al. further discloses the disc being eccentrically mounted on the axle (Fig. 1). Lambert et al. further discloses the disc being elliptical (Fig. 2).

However, Lambert et al. does not disclose a housing with the drive mechanism at least partly within the housing and the cutting element, axle, and bearing block being configured such that a cutting edge of the disc is exposed beyond the end of the bearing block distal to the housing for only a part of the eccentric rotation.

Miller et al. discloses a housing in the form of safety cover 181, with a drive mechanism within the housing and the cutting element only partially exposed during the cutting operation (Fig. 1). The housing of Miller et al. is roughly cylindrical (Fig. 1). The housing of Miller et al. is further capable of being used as a hand piece. Miller et al. further discloses a second cutting element 81. Miller et al. further discloses a direct motor drive and hydraulic means within the drive mechanism (Col. 5 ll. 40-55). Miller et al. further discloses the disc being circular (Fig. 15).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the device of Lambert et al. to include the housing of Miller et al. to facilitate the safe operation of the device.

Lambert et al. in view of Miller et al. further does not disclose the drive mechanism including pneumatic means.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the device of Lambert et al. in view of Miller et al. by substituting

the hydraulic means of Miller et al. with pneumatic means since it has been held that substituting a device known to be an equivalent structure is unpatentable.

Regarding claims 23-25: Since the eccentricity of the cutting element is based on either the shape of the cutting element or where the axis of rotation is mounted on a circular blade, it is an inherent property of the cutting element to provide a variable depth of cut, ramp angle, and rate of cut as the cutting element rotates through 360 degrees.

Allowable Subject Matter

3. Claims 4, 7, 9, 14, 30 and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. The following is a statement of reasons for the indication of allowable subject matter: The devices of Lambert et al. and Miller et al. are used for slicing meat or other products into same depth slices over multiple cuts. Neither the device of Lambert et al. nor of Miller et al. is capable of being used as a blunt force dissector or a tissue probe, and there would be no obvious reason to include electrocautery on either device. The nature of the housing of Miller et al. requires its radius to be much larger than its depth or altitude, and causing the housing to have an altitude greater than its radius would cause it to be unwieldy or render it inoperable. Neither Miller et al. nor Lambert et al. disclose the use of multiple discs mounted parallel on the same axis and mounting more than one blade on these devices would cause meat to become lodged between the blades thus destroying the devices proper function. Further, neither the prior art of

record nor the prior art at large can cure the deficiencies of Lambert et al. and Miller et al. alone or in combination.

Response to Arguments

2. Applicant's arguments filed 13 August 2009 have been fully considered but they are not persuasive. Regarding claim 1: In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the blade 27 of Miller et al. is not exposed beyond the housing) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The blade of Miller et al. is exposed during part of the rotation otherwise it would not cut the meat. The claim recites that the blade need be exposed beyond the end of the bearing block distal to the housing; since the blade is exposed, and the bearing block is mounted distal to the housing, the requirements of this limitation are met. Regarding claim 5: the housing of Miller et al. is capable of being grasped by the hand and thus it meets the requirements for a hand piece. Regarding claim 20: Applicant argues that blade 81 of Miller et al. is not a cutting element. Examiner disagrees: the blade 81 is designed as a sharp edge that encircles the vacuum screen; when the blade is put into contact with the bar of meat to be sliced, the vacuum pressure would draw the blade towards the meat and is capable of cutting into the meat slightly to form the resultant seal. Regarding claim 29: Applicant argues that the disc of Lambert et al. is not elliptical. Examiner disagrees: While the disc of Lambert et al. is not a full ellipse, the disc has an

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elliptical shape, if the blade were mirrored about its back edge, a full ellipse would be seen.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY ANDERSON whose telephone number is (571)270-3083. The examiner can normally be reached on Mon-Thurs 9:30AM-3PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on 571-272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gregory A Anderson/
/(Jackie) Tan-Uyen T. Ho/
Supervisory Patent Examiner, Art Unit 3773